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REMARKS

This is a full and timely response to the non-final Official Action mailed **February 25, 2008** (the "Office Action" or "Action"). Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

Under the imposition of a previous restriction requirement, claims 4-6, 17-24 and 30-40 have been withdrawn from consideration. Applicant will be entitled to rejoinder of these claims upon the allowance of the present independent claims. MPEP § 821.04

By the present amendment, claims 25 and 47 has been amended. Additionally, original claim 53 has been cancelled without prejudice or disclaimer. No other amendments to the application are proposed by the present paper. Thus, claims 1-3, 7-16, 25-29 and 41-52 are currently pending for further action.

Prior Art:

In the recent Office Action, claims 1-3, 7-16, 25-29 and 41-53 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of U.S. Patent Application Publication No. 2002/0116480 to Muto (hereinafter "Muto") and U.S. Patent Application Publication No. 2002/0075500 to Kurz et al. (hereinafter "Kurz"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

As evidenced by Muto, printing devices can generate and transmit email messages. However, such a printing device cannot produce an email message that it is not already programmed to generate. In contrast, Applicant's claims are directed to methods and devices for uploading new email messages into a printer that were not available to the printer before

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and which the printer can then transmit as needed. Thus subject matter is entirely outside the scope and content of the cited prior art. The Muto and Kurz references do not recognize or mention the issue addressed by Applicant's claims and cannot provide the same functions or advantages that are available from Applicant's disclosure.

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the aforementioned *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;

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- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

However, before any such rationale can be applied, the factual inquiries of *Deere* described above must be satisfied. In other words, the Office must make a *prima facie* case that all the elements of the claimed subject matter were taught or suggested by the cited prior art such that the art, when combined, renders obvious any differences between the cited prior art and the claimed subject matter. In the present case, the cited prior art clearly does not teach or suggest all the features of the claimed subject matter and no *prima facie* case of unpatentability has been made.

Claim 1:

Claim 1 recites: "A method of providing email messages to a printing device, said method comprising attaching a memory module storing said email messages to a printing device consumable." Applicant wishes to note that in claim 1 the email messages are provided or transmitted "to a printing device." (Claim 1) (emphasis added).

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According to the Examiner, Muto teaches a printing device that sends email messages to other devices. (Action, p. 3). However, the Examiner concedes that Muto does not teach a memory module attached to a printing device consumable. (Action, p. 3). Consequently, the Examiner cites Kurz as teaching a memory module on a replaceable component. (Action, p. 3).

However, Kurz merely teaches a "memory storage device containing data including an identification code of the replaceable component." (See paragraph [0009] of Kurz). Kurz does not teach or suggest the claimed memory module storing email messages. Neither Kurz nor Muto disclose a memory module that stores email messages.

Moreover, neither Muto nor Kurz disclose a method like that of claim 1 that includes "providing email messages to a printing device..." (emphasis added). Neither reference teaches or suggests anything about email messages being provided *to* a printing device. As indicated above, Muto teaches email messages being sent *from* a printing device and nothing about providing email messages *to* a printing device as recited in claim 1. Similarly, Kurz does not teach or suggest providing email messages *to* a printing device as recited in claim 1.

Again, under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Muto and Kurz, clearly did not include the claimed method of providing email messages *to a printing device* by "attaching a memory module storing said email messages to a printing device consumable." This difference between the cited prior art and the claimed subject matter is significant because the cited prior art does not teach or suggest an equivalent method for providing email messages to a printing device so that the

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printing device can then produce email messages it was not originally programmed to generate. Consequently, the cited prior art will not support a rejection of claim 1 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 7:

Claim 7 recites: "A method for providing email messages for email alerts from a printing device, said method comprising storing email messages on a memory module, attaching said memory module to a printing device consumable, installing said printing device consumable with attached memory module in a printing device, and interfacing said memory module with said printing device." Applicant wishes to note that claim 7 recite a method with a specific ordering of events, namely that the email messages are stored on a memory module and that the memory module is then interfaced with the printing device.

As noted above, neither Muto nor Kurz teach or suggest a method in which a memory module first stores email messages and is then interfaced with a printing device. Rather, as noted above, Kurz merely teaches a product identification code in an attached memory module. (Kurz, paragraph 0009).

Again, under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Muto and Kurz, clearly did not include the claimed method of first storing email messages on a memory module and then interfacing the memory module with the printing device. This difference between the cited prior art and the claimed subject matter is significant because the cited prior art does not teach or suggest an equivalent method

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for providing email messages to a printing device. Consequently, the cited prior art will not support a rejection of claim 7 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 41:

Claim 41 recites: "A consumable for use with a printing device, said consumable comprising a printing device consumable, a memory module attached to said printing device consumable, and email messages stored on said memory module." Applicant wishes to note that in claim 41 email messages are stored on a memory module of a consumable with or without the consumable being installed in a printing device. Thus, as recited in claim 41, the consumable with a memory module storing email messages can exist entirely apart from a printing device.

In contrast, as demonstrated above, Muto teaches a printing device that can generate and transmit email messages. (Muto, paragraph 0010). Neither Muto nor Kurz, however, teach or suggest a memory module on a consumable entirely apart from a printing device that stores email messages. This subject matter is entirely outside the scope of the cited prior art.

Again, under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Muto and Kurz, clearly did not include the claimed consumable, apart from a printing device, wherein "email messages [are already] stored on [a] memory module" attached to the consumable. This difference between the cited prior art and the claimed subject matter is significant because the cited prior art does not teach or suggest an equivalent means, such as a printing device consumable with an attachable memory module

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containing email messages, for providing new email messages to a printing device. Consequently, the cited prior art does not provide the advantages of the claimed subject matter and will not support a rejection of claim 41 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 47:

Claim 47 recites:

A printing device comprising:
a printing device controller with an email engine for using email messages provided by a memory module attached to a printing device consumable;
a printing device memory storing said email engine; and
a printing device interface disposed and configured to interface and communicate with said memory module attached to a printing device consumable supplied to said printing device:

wherein said printing device controller is configured to access email messages in said memory module attached to said consumable, load said email messages into said printing device memory and selectively transmit said email messages using said email engine.

(Emphasis added).

Applicant wishes to note that in claim 47 "said printing device controller is configured to access email messages in said memory module attached to said consumable, load said email messages into said printing device memory and selectively transmit said email messages using said email engine."

As demonstrated above, neither Muto nor Kurz teaches or suggests a memory module on a consumable device that stores email messages. Consequently, Muto and Kurz, taken in any combination, must also fail to teach or suggest the claimed printing device having a controller "configured to access email messages in said memory module attached to said consumable, load said email messages into said printing device memory and selectively transmit said email messages using said email engine."

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Again, under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Muto and Kurz, clearly did not include the claimed printing device comprising said printing device controller is configured to access email messages in said memory module attached to said consumable, load said email messages into said printing device memory and selectively transmit said email messages using said email engine. This difference between the cited prior art and the claimed subject matter is significant because the cited prior art does not teach or suggest an equivalent system for providing new email messages to a printing device that can then be selectively transmitted by that printing device. Consequently, the cited prior art will not support a rejection of claim 1 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Dependent Claims:

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 3 recites "uploading said email messages from said memory module to a memory of said printing device." Claim 9 recites similar subject matter. As demonstrated above, for example, with respect to claim 47, neither Muto nor Kurz disclose transferring email messages from a memory module to a printing device. For at least this reason, the rejection of these claims should be reconsidered and withdrawn.

Claim 11 recites "wherein said email messages comprise fields for containing printing device information." As disclosed in paragraphs [0033], and [0054]-[0060], and Fig. 6 of the

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present application, a user may customize email message elements on the memory module including fields contained within the email message. In contrast, as demonstrated above, neither Muto nor Kurz teach or suggest email messages stored on a memory module of a printing device consumable. Consequently, the cited prior art cannot teach or suggest such messages comprising fields for containing printing device information. For at least this reason, the rejection of claim 11 should be reconsidered and withdrawn.

Claims 15 and 16 recite, respectively, that sending an email alert comprises "monitoring operation of a printing device for occurrence of a trigger event; *inserting said printing device information into said email message*; and sending said email alert using the email messages in response to said trigger event, wherein the email messages are specific to the trigger event detected," and "receiving user input to specify a list of trigger events." (Emphasis added). As disclosed in paragraphs [0033], and [0054]-[0060], and Fig. 6 of the present application, a user may customize email message elements on the memory module including fields contained within the email message. In contrast, neither Muto nor Kurz disclose a method wherein email messages contain fields that may be altered or customized by a user. For at least this reason, the rejection of these claims should be reconsidered and withdrawn.

Claim 25 recites a method for providing email messages for email alerts from a printing device comprising *uploading said email messages from said memory module to a memory unit of said printing device*:

wherein said uploading said email message elements to printing device memory comprises:
determining if previous email message elements already exist in said printing device memory; and
uploading said email message elements to printing device memory if no previous email message elements are found.

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Claim 26 recites similar subject matter. In contrast, as demonstrated above, for example, with respect to claim 47, neither Muto nor Kurz disclose transferring email messages from a memory module to a printing device. This subject matter is entirely outside the scope and content of the cited prior art. For at least this reason, the rejection of these claims should be reconsidered and withdrawn.

Claim 29:

Claim 29 was rejected under 35 U.S.C. § 103(a) over the combined teachings of Kurz, Muto and U.S. Patent No. 6,831,755 to Narushima. This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim

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Claim 42:

Claim 42 was rejected under 35 U.S.C. § 103(a) over the combined teachings of Kurz, and U.S. Patent App. Pub. No. 2003/0214546 to Hatasa ("Hatasa"). Applicant presumes this rejection is also made in reliance on Muto, given that Muto was used in rejecting the corresponding independent claim. In any event, this rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim 41.

Claim 43 and 44:

Claims 43 and 44 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Kurz, Hatasa and U.S. Patent No. 6,532,351 to Richards ("Richards"). Applicant presumes this rejection is also made in reliance on Muto, given that Muto was used in rejecting the

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corresponding independent claim. In any event, this rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim 41.

Claim 48

Claim 48 was rejected under 35 U.S.C. § 103(a) over the combined teachings of Kurz, Muto and Hatasa. This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim 47.

Claims 49 and 50:

Claims 49 and 50 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Kurz, Muto, Hatasa and Richards. This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of claim 47.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any

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claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: May 23, 2008

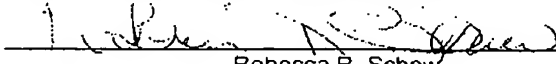

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Rebecca R. Schow